

REMARKS/ARGUMENTS

The Office Action of September 30, 2004 has been carefully reviewed and this response addresses the Examiner's concerns stated in the Office Action. All objections and rejections are respectfully traversed.

Claims 1-18, 21-22, and 24-43 are pending in the application. Claims 25-28 have been allowed, claims 6, 16-18, 30, and 40 have been objected to as being dependent on rejected base claims, and claims 1-5, 7-15, 19-24, 29, and 31-39 have been rejected. Claims 1, 5-6, 9, 14-18, 21-22, and 24-40 have been amended to clarify the claimed invention. Thus the amended claims are not intended to further limit the original claims. Claims 19, 20, and 23 have been cancelled without prejudice. Claims 41-43 have been added.

Claim Rejections - 35 USC § 102(e)

On pages 2-3, paragraphs 1-2 of the Office Action, Examiner has rejected claims 1, 2, 7, and 9 under 35 U.S.C. § 102(e) as being anticipated by Treyz et al., U.S. Patent No. 6,587,835, issued July 1, 2003 (Treyz). Applicants respectfully point out that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (CAFC, 1987), M.P.E.P. § 2131. As provided by the remarks set forth below, clearly this is not the case with the present rejection of the claims. In summary, Treyz does not anticipate Applicants' invention because:

(1) Applicants claim a *transmitter* with defined context such that a handheld device receives contextually-relevant information formatted by the transmitter. The transmitter can determine contextually-relevant information and provide only that information to the handheld device, thus relieving the handheld device of the need to perform this task.

(2) Treyz discloses a *handheld computing device* that performs a myriad of functions including determining its locational context (col. 23, lines 40-43). Treyz discloses transmitting messages to all handheld computing devices in local wireless communications with local wireless transmitter/receivers in an area. To avoid collecting too many messages, the handheld

computing device may automatically delete or cancel messages to which the user does not respond (col. 40, lines 20-50), directly indicating the user's level of interest and personal context. Thus, the system of Treyz relies on the handheld computing device to determine both locational and personal contexts.

Applicants further respectfully point out that Examiner's cited reference, Treyz, was issued on July 1, 2003, almost two years after the filing date of the present application, August 15, 2001. Treyz was filed on February 9, 2000, whereas Applicants' provisional patent application upon which the present application depends was filed on August 15, 2000. Applicants respectfully reserve the right to file a petition under 37 C.F.R. § 1.131 to swear behind Treyz.

Applicants have amended claim 1 to clarify the original intent of claim 1 as follows:

Claim 1: (currently amended) A transmitter for receiving information from a service provider about a service and for conveying the information to a handheld device, said transmitter comprising:

- means for defining a context in said transmitter;
- means for receiving the information at said transmitter;
- means for formatting the information in said transmitter into a machine-readable form to produce a transmitted signal compatible with the handheld device and relevant to said context;
- and
- means for conveying said transmitted signal from said transmitter to the handheld device located within said context, said information displayed to a user of the handheld device if the user has previously expressed an interest in the service.

Applicants respectfully request Examiner to reconsider the rejection in light of Applicants' amendments and the following arguments. To further Applicants' position of the patentability of amended claim 1 (and amended claims 2-8 that depend from amended claim 1), Applicants note the following.

With respect to claim 1, Examiner states that Treyz includes a transmitter/receiver for receiving an advertisement containing information from a service provider and for conveying said advertisement to a handheld device, said transmitter comprising the following:

(1) Examiner states that Treyz includes a transmitter comprising a means for defining a context for said transmitter (col. 23, lines 26-35: context meaning location).

As a rebuttal to Examiner's position, Applicants respectfully point out that Treyz discloses that the location of a handheld computing device can be determined when the device is communicating with a particular local wireless transmitter/receiver. As previously pointed out, Treyz further discloses that the handheld computing device determines its locational context. Applicants, on the contrary, claim a means for defining a context for said transmitter. Nowhere does Treyz define a context for a transmitter.

(2) Examiner states that Treyz includes a transmitter comprising a means for receiving said advertisement (col. 1, lines 45-48 and col. 38, lines 38-46).

As a rebuttal to Examiner's position, Applicants respectfully point out that Treyz discloses that advertisements are received by the handheld device. On the contrary, Applicants claim a means for receiving information at the transmitter, where a context has been defined for the transmitter. Although it is clear from the disclosure of Treyz that the advertisements must travel through a transmitter and thus must be received by the transmitter, nowhere does Treyz disclose or suggest that the transmitter has a defined context.

(3) Examiner states that Treyz includes a transmitter comprising a means for formatting said advertisement into a machine-readable form to produce a transmitted signal compatible with said handheld device (col. 55, lines 30-40 – device displays advertisement, thus, formatting is inherently performed).

As a rebuttal to Examiner's position, Applicants respectfully point out that Treyz discloses a handheld device displaying an advertisement on itself. In particular, the handheld device of Treyz, when determining its locational context as being on the ice cream isle, displays

advertisements with respect to ice cream (col. 55, lines 34-38). On the contrary, Applicants claim a means for formatting information in the transmitter. Nowhere does Treyz disclose or suggest that the transmitter formats information into a machine-readable form to produce a transmitted signal compatible with the handheld device.

(4) Examiner states that Treyz includes a transmitter comprising a means for conveying said transmitted signal to said handheld device located within said context, said information displayed to a user of said handheld device if said user has previously expressed an interest in said service (col. 30, lines 3-21; col. 14, lines 14-40; col. 39, lines 6-62; col. 56, lines 46-51; and col. 54, lines 23-52).

As a rebuttal to Examiner's position, Applicants respectfully point out that Treyz discloses a shopping assistance service that can provide information of interest to the user, a handheld device that can receive information and can track information that the user deletes in order to determine what the user is interested in, and a method for providing a user of a handheld device with the shopping assistance service. Nowhere does Treyz disclose a means for conveying a transmitted signal that contains formatted information that is formatted in the transmitter having a defined context to the handheld device located within the context, the information being displayed to a user of the handheld device if the user has previously expressed an interest in the service.

In summary, Applicants have claimed a transmitter that takes an active role in the process of discerning which information is relevant to which users, and also takes an active role in formatting the information so that it can be properly displayed on the handheld device to which it is destined. Since Treyz does not anticipate each and every element of Applicants' amended claim 1, either expressly or inherently, Applicants' amended claim 1 (as well as claims 2-7 that depend, either directly or indirectly, therefrom and that further define the invention) is not made obvious by Treyz, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicants assert that amended claim 1 (as well as claims 2-7 that depend, either directly or indirectly, therefrom) is now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 102(e) with regards to amended claim 1, and claims 2-7 which depend, either

directly or indirectly, therefrom, for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Treyz to meet Applicants' patentable limitations.

On page 3 of the Office Action, with respect to dependent claim 2, which depends from claim 1, Examiner states that Treyz meets the limitation – The transmitter of claim 1 wherein said conveying means transmits a diffuse infrared signal (col. 13, lines 10-15 and col. 30, lines 3-21). Further, on page 3 of the Office Action, with respect to dependent claim 7, which depends from claim 1, Examiner states that Treyz meets the limitation – The transmitter of claim 1 further comprising means for receiving a reply from said handheld device (col. 20, line 57 to col. 22, line 15).

As a rebuttal to Examiner's position, Applicants respectfully point out that Treyz discloses communications between the handheld device and a merchant computer (or other computer) through transmitters/receivers. Applicants, on the contrary, claim a transmitter with defined context, where the transmitter can transmit by diffuse infrared signals, and where the transmitter can receive a reply from the handheld device. As previously stated, nowhere does Treyz disclose a transmitter with defined context having Applicants' claimed capabilities. Since Treyz does not anticipate each and every element of Applicants' dependent claims 2 and 7, either expressly or inherently, Applicants' dependent claims 2 and 7 (as well as dependent claims 3-4 that depend therefrom and that further define the invention) are not anticipated by Treyz, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicants assert that dependent claims 2 and 7 (as well as dependent claims 3-4 that depend therefrom) are now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 102(e) with regards to dependent claims 2 and 7, and claims 3-4 which depend therefrom, for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Treyz to meet Applicants' patentable limitations.

Applicants have amended claim 9 to clarify the original intent of claim 9 as follows:

Claim 9 (currently amended) A handheld device operating in a context associated with a transmitter conveying a transmitted signal, said handheld device comprising:

means for receiving said transmitted signal to form a received signal, said transmitted signal being formatted by the transmitter, said received signal including information from a service provider offering a service, said received signal further being present if said handheld device is located within said context, said context being communicatively associated with said transmitter; and

means for extracting said information if a user of said handheld device has expressed an interest in such a service.

Applicants respectfully request Examiner to reconsider the rejection in light of Applicants' amendments and the following arguments. To further Applicants' position of the patentability of amended claim 9 (and amended claims 10-18 that depend, directly or indirectly, from amended claim 9), Applicants note the following.

On page 3 of the Office Action, with respect to independent claim 9, Examiner states that Treyz includes a handheld device operating in a context associated with a transmitter / receiver conveying a transmitted signal, in which a received signal is present if said handheld device is located within said context, said context being communicatively associated with said transmitter (col. 39, lines 6-62).

As a rebuttal to Examiner's position, Applicants respectfully point out that Treyz discloses a handheld device that displays messages in response to communications from nearby merchants. Treyz discloses that the handheld device can display these messages when it detects the presence of local wireless transmissions from the local wireless transmitter/receiver. On the contrary, Applicants claim a handheld device operating in a context associated with a transmitter that is conveying a transmitted signal, in which the transmitted signal is formatted by the transmitter. Nowhere does Treyz disclose a handheld device that is receiving a signal that is formatted by a transmitter. Since Treyz does not anticipate each and every element of Applicants' independent claim 9, either expressly or inherently, Applicants' independent claim 9

(as well as dependent claims 10-18 that depend, either directly or indirectly, therefrom and that further define the invention) is not anticipated by Treyz, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicants assert that independent claim 9 (as well as dependent claims 10-18 that depend, either directly or indirectly, therefrom) is now in condition for allowance.

Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 102(e) with regards to independent claim 9, and dependent claims 10-18 which depend, either directly or indirectly, therefrom, for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Treyz to meet Applicants' patentable limitations.

Claim Rejections - 35 USC § 103

On pages 4-12, paragraphs 3-4 of the Office Action, Examiner has rejected claims 3-5, 8, 10-15, 19-24, 29, and 31-39 under 35 U.S.C. § 103(a) as being unpatentable over Treyz in view of Aufricht et al., U.S. Patent Application No. 2002/0052781, published on May 2, 2002 (Aufricht).

Applicants respectfully point out that Examiner's cited reference, Aufricht, was published on May 2, 2002, almost one year after the filing date of the present application, August 15, 2001. Applicants respectfully reserve the right to file a petition under 37 C.F.R. § 1.131 to swear behind Aufricht.

Applicants assert that dependent claims 3-4 depend upon claim 2, as argued above, and therefore should also be found to be allowable.

Applicants have amended dependent claim 5 to clarify the original intent of claim 5 as follows:

Claim 5 (currently amended) The transmitter of claim 2 wherein said machine-readable form is an XML element.

Applicants respectfully request Examiner to reconsider the rejection in light of Applicants' amendments and the following argument. To further Applicants' position of the patentability of amended claim 5 (and claim 6 that depends from amended claim 5), Applicants note the following.

On page 5 of the Office Action, with respect to dependent claim 5,

(1) Examiner states that Treyz is silent regarding information transmitted in the form of an XML element.

(2) Examiner states that Aufricht discloses an interactive advertisement mechanism enabled to be loaded on a mobile device and for users of mobile devices to operate with such interactive advertisements on their mobile devices in an interactive manner while in an off-line mode.

Applicants respectfully point out that Applicants claim a transmitter communicating with a handheld device. Thus the handheld device is not in an off-line mode.

(3) Examiner states that Aufricht allows for placing objects such as interactive advertisements such as Internet of Web content on mobile devices (paragraph 33). Examiner states that Aufricht meets the following limitation: The transmitter of claim 2 wherein said information in the form of an XML element (paragraph 33 and Table 1 [placing interactive advertisements from the internet or Web content to mobile devices with XML being one of the allowable forms]).

As a rebuttal to Examiner's position, Applicants respectfully point out that, as Examiner has stated, Aufricht discloses an interactive advertisement mechanism enabled to be loaded on a mobile device. On the contrary, Applicants claim a transmitter for receiving information and conveying the information to a handheld device, where the transmitter formats the information into a machine-readable form that is an XML element. Nowhere do either Treyz or Aufricht disclose or suggest a transmitter for receiving information, where the transmitter formats the information into a machine-readable form that is an XML element.

(4) Examiner states that at the time of Applicants' invention, it would have been obvious to modify Treyz to include XML elements in communicating from the server transmitter to the user's handheld in order to provide a more refined presentation at the user's handheld.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Applicants assert that there is no suggestion nor motivation in either Treyz or Aufricht to format information in the transmitter. Since Treyz and Aufricht, separately or in combination, do not teach or suggest each and every element of Applicants' amended dependent claim 5, which depends upon amended claim 1, either expressly or inherently, Applicants' amended dependent claim 5 (as well as dependent claim 6 that depends therefrom and that further defines the invention) is not made obvious by Treyz and Aufricht, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that amended dependent claim 5 (as well as dependent claim 6 that depends therefrom) is now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to amended dependent claims 5-6 for the reasons set forth above.

On page 5 of the Office Action, with respect to dependent claims 8, 10, 22, 33, and 38, Examiner takes Official Notice that it is well known to utilize plug-ins associated with interest and that it would have been obvious to modify the Treyz/Aufricht combination to include plug-ins to connect a desired user with the desired interest and filter out those that do not share the interest.

Applicants respectfully rebut the Official Notice taken that Applicants' utilization of plug-ins associated with interest would have been obvious to one having ordinary skill in the art at the time the invention was made. Applicants respectfully point out that, "[O]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961))." MPEP § 2144.03 A. Although plug-ins themselves are in common use, plug-ins associated with an interest that filter contextually-relevant data are not in common enough use so that a reference to their use can be found by a simple search of the internet. Further, Applicants' use of plug-ins associated with an interest that filter contextually-relevant data in combination with Applicants' other claimed features is not an obvious extension of Treyz, Aufricht, or their combination. Applicants respectfully request that Examiner provide a reference for the use of plug-ins associated with an interest that filter contextually-relevant data.

In order for a rejection under 35 U.S.C. §103 to be sustained, the Examiner must establish a prima facie case of obviousness. As pointed out in MPEP § 2142, one of the three criteria to establish a prima facie case of obviousness is that the prior art reference(s) must teach or suggest all the claim limitations. As discussed above by Applicants in the Remarks/Arguments of the 35 U.S.C §102(e) rejections, Treyz does not anticipate all the claimed limitations of independent claims 1 and 9, and therefore dependent claims 8 and 10. Further, Treyz and Aufricht do not teach or suggest the claimed limitations of dependent claims 22, 33, and 38, which depend from claims 25, 29, and 37, as neither Treyz, Aufricht, nor Official Notice teaches or suggests plug-ins used to connect a desired user with the desired interest and filter out those that do not share the interest. Therefore, Treyz and Aufricht combined with Official Notice are not sufficient to sustain a rejection under 35 U.S.C. §103 for dependent claims 8, 10, 22, 33, and 38.

Since Treyz, Aufricht, and Official Notice, separately or in combination, do not teach or suggest each and every element of Applicants' dependent claims 8, 10, 22, 33, and 38, which depend upon amended independent claims 1, 9, 25, 29, and 37, either expressly or inherently, Applicants' dependent claims 8, 10, 22, 33, and 38 are not made obvious by Treyz, Aufricht, and Official Notice, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that dependent claims 8, 10, 22, 33, and 38 are now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to dependent claims 8, 10, 22, 33, and 38 for the reasons set forth above.

On page 6 of the Office Action, with respect to dependent claims 11 and 31, which depend from independent claims 9 and 29 respectively, Examiner states that Treyz meets the limitation – The handheld device of claim 9 wherein said transmitted signal is a diffuse infrared signal (col. 13, lines 10-15 and col. 30, lines 3-21). Applicants have cancelled claim 23

As a rebuttal to Examiner's position, Applicants reiterate that Treyz discloses communications between the handheld device and a merchant computer (or other computer) through transmitters/receivers. Applicants, on the contrary, claim (claim 9) a handheld device operating in a context associated with a transmitter, where the transmitted signal is a diffuse infrared signal. Applicants respectfully draw Examiner's attention to arguments directed to claim 29 below. Nowhere does Treyz disclose a handheld device operating in a context associated with a transmitter which formats the transmitted signal. Since Treyz and Aufricht, separately or in combination, do not teach or suggest each and every element of Applicants' dependent claims 11 and 31, which depend upon amended independent claims 9 and 29, either expressly or inherently, Applicants' dependent claims 11 and 31 are not made obvious by Treyz and Aufricht, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that dependent claims 11 and 31 are now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to dependent claims 11 and 31 for the reasons set forth above.

On page 6 of the Office Action, with respect to dependent claim 12, Examiner states that Treyz meets the limitation – The handheld device of claim 9 further comprising means for

displaying at least a portion of said information to said user (col. 10, lines 9-19). On page 6 of the Office Action, with respect to dependent claim 13, Examiner states that Treyz meets the limitation – The handheld device of claim 12 further comprising means for accepting an input from said user, said input provided in response to said at least a portion of said information (col. 20, line 75 to col. 22, line 15).

As a rebuttal to Examiner's position, Applicants reiterate that Treyz discloses communications between the handheld device and a merchant computer (or other computer) through transmitters/receivers. Applicants, on the contrary, claim (claim 12) a handheld device operating in a context associated with a transmitter conveying a transmitted signal, where the transmitted signal contains information that is formatted by the transmitter. Nowhere does Treyz disclose a handheld device that receives information that is formatted by the transmitter. Since Treyz and Aufricht, separately or in combination, do not teach or suggest each and every element of Applicants' dependent claim 12 (and dependent claim 13 which depends therefrom), which depends upon amended independent claim 9, either expressly or inherently, Applicants' dependent claim 12 (and dependent claim 13 which depends therefrom) is not made obvious by Treyz and Aufricht, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that dependent claim 12 (and dependent claim 13 which depends therefrom) is now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to dependent claim 12 (and dependent claim 13 which depends therefrom) for the reasons set forth above.

On page 6 of the Office Action, with respect to dependent claim 14, Examiner states that Aufricht meets the limitation – The handheld device of claim 11 wherein said transmitter further includes means for receiving a reply from said handheld device, said reply generated in response to said input (paragraph 232) (also Treyz, col. 41, lines 1-25).

As a rebuttal to Examiner's position, Applicants reiterate that as Examiner has stated, Aufricht discloses an interactive advertisement mechanism enabled to be loaded on a mobile device. Applicants, on the contrary, claim (claims 9 and 14) a handheld device operating in a context associated with a transmitter, where the transmitter formats the transmitted signal, and

where the transmitter further includes a means for receiving a reply from the handheld device. Nowhere does Aufricht disclose a handheld device operating in a context associated with a transmitter that formats a transmitted signal and where the transmitter can receive a reply from the handheld device. Since Aufricht does not teach or suggest each and every element of Applicants' dependent claim 14, which depends upon amended independent claim 9, either expressly or inherently, Applicants' dependent claim 14 is not made obvious by Treyz/Aufricht, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that dependent claim 14 is now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to dependent claim 14 for the reasons set forth above.

On page 6 of the Office Action, with respect to claim 15, Examiner states that Aufricht meets the limitation – The handheld device of claim 9 wherein said advertisement is comprised of a first XML element (paragraph 33 and Table 1 [placing interactive advertisements from the internet or Web content to mobile devices with XML being one of the allowable forms]).

As a rebuttal to Examiner's position, Applicants reiterate that as Examiner has stated, Aufricht discloses an interactive advertisement mechanism enabled to be loaded on a mobile device. The mobile device of Aufricht is not operating in a context that is associated with a transmitter, where the transmitter formats the advertisement. Applicants, on the contrary, claim (claims 9 and 15) a handheld device operating in a context associated with a transmitter, where the transmitter formats the transmitted signal, and where the transmitter transmits information that includes a first XML element. Nowhere does Aufricht disclose a handheld device operating in a context associated with a transmitter that formats a transmitted signal and that transmits information including a first XML element. Since Aufricht does not teach or suggest each and every element of Applicants' dependent claim 15 (and dependent claims 16-18 that depend, directly or indirectly therefrom), which depends upon amended independent claim 9, either expressly or inherently, Applicants' dependent claim 15 (and dependent claims 16-18 that depend, directly or indirectly therefrom) is not made obvious by Treyz/Aufricht, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that dependent claim 15 (and

dependent claims 16-18 that depend, directly or indirectly therefrom) is now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to dependent claim 15 (and claims dependent 16-18 that depend, directly or indirectly therefrom) for the reasons set forth above.

Applicants have cancelled independent claim 19 and dependent claim 20.

Applicants have amended independent claim 21 to depend from independent claim 25 as follows:

Claim 21: (currently amended) The method of claim 25 further comprising the step of utilizing a behavior of the user to establish the preference.

Applicants respectfully request Examiner to reconsider the rejection in light of Applicants' amendments and the following argument. To further Applicants' position of the patentability of amended claim 21, Applicants note the following.

On page 8 of the Office Action, with respect to dependent claim 21, Examiner states that Treyz meets the limitation – The method of claim 19 further comprising the step of utilizing a behavior of said user to establish said preference (col.55, lines 30-40).

As a rebuttal to Examiner's position, Applicants respectfully point out that Treyz discloses a handheld device displaying an advertisement on itself. In particular, the handheld device of Treyz, when determining its locational context as being on the ice cream isle, displays advertisements with respect to ice cream (col. 55, lines 34-38). On the contrary, Applicants claim a method for establishing a context of a user associated with a transmitter where the transmitter formats the information that is sent to a handheld device. Applicants further claim that, with respect to establishing a context, the method includes the step of utilizing the behavior of the user to establish a preference. Nowhere does Treyz disclose or suggest a method for establishing a context that includes a transmitter that formats information into a machine-readable form to produce a transmitted signal compatible with the handheld device, and that

utilizes the behavior of the user to establish a preference. Since Treyz does not teach or suggest each and every element of Applicants' dependent claim 21, which depends upon amended independent claim 25, either expressly or inherently, Applicants' dependent claim 21 is not made obvious by Treyz, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that dependent claim 21 is now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to dependent claim 21 for the reasons set forth above.

Applicants have amended independent claim 29 to clarify the original intent of claim 29 as follows:

Claim 29: (currently amended) A method for receiving contextual information contained in an emitted signal formatted by and received from a transmitter having a coverage area associated therewith, said method comprising the steps of:

- establishing a preference for the contextual information;
- receiving the emitted signal containing the contextual information formatted by the transmitter, the contextual information included in a broadcast XML element;
- processing the broadcast XML element to extract the contextual information; and
- displaying at least a portion of the contextual information to the user located within the coverage area if the preference was established prior to receiving the broadcast XML element;

wherein the contextual information is received from the transmitter.

Applicants respectfully request Examiner to reconsider the rejection in light of Applicants' amendments and the following argument. To further Applicants' position of the patentability of amended claim 29 (and amended claims 30-33 that depend from amended claim 29), Applicants note the following.

On page 9 of the Office Action, with respect to independent claim 29,

(1) Examiner states that Treyz describes a method for receiving contextual information contained in an emitted signal received from a transmitter having a coverage area associated

therewith, said method comprising the steps of: establishing a preference for said information (col. 55, lines 30-40).

As a rebuttal to Examiner's position, Applicants respectfully point out that Treyz discloses that promotional material may be targeted based on the user's preferences and interests and based on the user's location in the supermarket. As previously pointed out, Treyz further discloses that the handheld computing device determines its locational context. Nowhere does Treyz disclose contextual information contained in an emitted signal formatted by and received from a transmitter comprising the step of establishing a preference for the information. Applicants have reviewed the entire Treyz disclosure and have concluded that either the handheld device or a merchant or service provider prepares contextual information. Nowhere does Treyz disclose or suggest Applicants' claimed contextual information contained in an emitted signal formatted by a transmitter.

(2) Examiner states that Treyz is silent on passing the information transmitted to the handheld device formatted of an XML element.

(3) Examiner states that Aufricht discloses an interactive advertisement mechanism enabled to be loaded on a mobile device and for users of mobile devices to operate with such interactive advertisements on their mobile devices in an interactive manner while in an off-line mode.

Applicants respectfully point out that Applicants claim a method for receiving contextual information contained in an emitted signal formatted by and received from a transmitter. Applicants have not claimed, in claim 29, a device that is in off-line mode.

(4) Examiner states that Aufricht allows for placing objects such as interactive advertisements such as Internet or Web content on mobile devices (paragraph 33). Examiner states that Aufricht meets the following limitation: receiving said signal containing said information, said information included in a broadcast XML element (paragraph 33 and Table 1) [placing interactive advertisements from the Internet or Web content to mobile devices with XML being one of the allowable forms; also broadcasting of the information (paragraph 211)];

As a rebuttal to Examiner's position, Applicants respectfully point out that, as Examiner states, Aufricht allows for placing objects such as interactive advertisements such as Internet or Web content on mobile devices (paragraph 33). Aufricht also discloses a server that selects advertisements based on user preferences. Nowhere does Aufricht disclose a method for receiving contextual information formatted by a transmitter.

(5) Examiner states that at the time of Applicants' invention, it would have been obvious to modify Treyz to include XML elements in communicating from the server transmitter to the user's handheld in order to provide a more refined presentation at the user's handheld.

Applicants respectfully assert that the three basic criteria to establish obviousness have not been met. There is no suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference such that the transmitter formats and delivers the contextual information to the user. Applicants respectfully point out that since Treyz and Aufricht, separately or in combination, do not teach or suggest each and every element of Applicants' amended claim 29, either expressly or inherently, Applicants' amended claim 29 (as well as amended claims 30-33 that depend, either directly or indirectly, therefrom and that further define the invention) is not made obvious by the Treyz and Aufricht, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that amended claim 29 (as well as amended claims 30-33 that depend, directly or indirectly, therefrom) is now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 103(a) with regards to amended claims 29-33 for the reasons set forth above.

Applicants have amended independent claim 34 to clarify the original intent of claim 34 as follows:

Claim 34: (currently amended) A method of utilizing executable code in a transmitter to establish a context of a user having a handheld device and operating within a coverage area associated with the transmitter, the method comprising the steps of:

receiving information about a service at the transmitter, the information being of interest to the user of the handheld device if the user is located within the coverage area;

formatting, in the transmitter, the information into an XML element for conversion into a signal; and

emitting the signal, from the transmitter, to the handheld device located within the coverage area, the information displayed to the user of the handheld device.

Applicants respectfully request Examiner to reconsider the rejection in light of Applicants' amendments and the following argument. To further Applicants' position of the patentability of amended claim 34 (and amended claims 35-36 that depend from amended claim 34), Applicants note the following.

On page 10 of the Office Action, with respect to independent claim 34,

(1) Examiner states that Treyz discloses a system in which a handheld computing device may be used to provide a user with shopping assistance services and a method of utilizing executable code in a transmitter to establish a context of a user having a handheld device and operating within a coverage area associated with said transmitter, said method comprising the steps of receiving information about a service at said transmitter, said information being of interest to a user of said handheld device if said user is located within said coverage area (col. 55, lines 30-40).

As a rebuttal to Examiner's position, Applicants respectfully point out that Treyz discloses that promotional material such as advertisements may be displayed, and that the promotional material may be targeted based on the user's preferences, interests, and location. Nowhere does Treyz disclose a method of utilizing executable code in a transmitter to establish a context in which the method includes a step of receiving information about a service at the transmitter, the information being of interest to the user of the handheld device if the user is located within the coverage area, the information being formatted in the transmitter.

(2) Examiner states that Treyz is silent regarding information transmitted in the form of an XML element.

(3) Examiner states that Aufricht discloses an interactive advertisement mechanism enabled to be loaded on a mobile device and for users of mobile devices to operate with such interactive advertisements on their mobile devices in an interactive manner while in an off-line mode.

Applicants respectfully point out that Applicants claim a method for utilizing executable code in a transmitter to establish a context of a user having a handheld device and operating within a coverage area associated with the transmitter. Thus the handheld device is not in an off-line mode.

(4) Examiner states that Aufricht allows for placing objects such as interactive advertisements such as Internet of Web content on mobile devices (paragraph 33). Examiner states that Aufricht meets the following limitation: formatting said information into an XML element for conversion into a signal (paragraph 33 and Table 1 [placing interactive advertisements from the internet or Web content to mobile devices with XML being one of the allowable forms]).

As a rebuttal to Examiner's position, Applicants respectfully point out that, as Examiner states, Aufricht allows for placing objects such as interactive advertisements such as Internet or Web content on mobile devices (paragraph 33). Aufricht also discloses a server that selects advertisements based on user preferences. Nowhere does Aufricht disclose a method for utilizing executable code in a transmitter to format, in the transmitter, information received at the transmitter into an XML element for conversion into a signal, where the signal is sent to the handheld device.

On page 11 of the Office Action, with respect to dependent claim 35, Examiner states that Treyz meets the limitation – The method of claim 34 wherein said information is only displayed to said user if said user has established a preference prior to receiving said signal (col. 39, lines 49-62).

As a rebuttal to Examiner's position, Applicants respectfully point out that Treyz discloses displaying a proximity message on the handheld computing device automatically when the user comes within range of a local wireless transmitter / receiver in the proximity of the given merchant. Treyz further discloses that the information may be displayed when the handheld computing device detects the presence of local wireless transmissions from the local wireless transmitter / receiver. Applicants, on the contrary, claim a method of utilizing executable code in a transmitter to establish a context, and to receive, format, and emit information to a handheld computer that is only displayed on the handheld device if the user has established a preference prior to receiving the contextual information from the transmitter. Nowhere does Treyz disclose a method for utilizing executable code in a transmitter that governs whether or not information is displayed on the handheld device. The handheld device of Treyz determines the proximity to the transmitter and automatically displays a message.

On page 11 of the Office Action, with respect to dependent claim 36, Examiner states that Treyz meets the limitation -- The method of claim 34 further comprising the steps of: generating a time element (paragraph 165); and emitting said time element in conjunction with said XML element, said time element for use in establishing a temporal context for said user (paragraphs 165 and 33 and Table 1 [placing interactive advertisements from the internet or Web content to mobile devices with XML being one of the allowable forms]).

Applicants assume that Examiner is referring to Aufricht, not Treyz, in the rejection of claim 36. However, clarification of the rejection is requested. As a rebuttal to Examiner's position, Applicants respectfully point out that Aufricht allows for placing objects such as interactive advertisements such as Internet or Web content on mobile devices (paragraph 33). Aufricht also discloses a server that selects advertisements based on user preferences, including sending advertisements based on, for example, normal events at a certain time of day. Nowhere does Aufricht disclose a method for utilizing executable code in a transmitter to generate a time element and emit the time element from the transmitter in conjunction with the XML element for conversion into a signal, where the signal is sent to the handheld device. The advertisement of Aufricht is generated in the server based on a certain time, but nowhere does Aufricht disclose

that a time element is generated in the transmitter and accompanies the XML element from the transmitter to the handheld device.

Since Treyz and Aufricht, separately or in combination, do not teach or suggest each and every element of Applicants' amended claims 34-36, either expressly or inherently, Applicants' amended claims 34-36 are not made obvious by the Treyz and Aufricht, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that amended claims 34-36 are now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 103(a) with regards to amended claims 34-36 for the reasons set forth above.

Applicants have amended independent claim 37 to clarify the original intent of claim 37 as follows:

Claim 37: (currently amended) A method of utilizing executable code in a handheld device receiving a signal formatted by a transmitter, said method comprising the steps of:

- establishing a preference for information contained in the signal, the information being formatted by the transmitter as an XML element;

- receiving the signal at a communication interface communicatively associated with the handheld device;

- processing the signal to extract the information contained therein; and

- displaying at least a portion of the information to the user located within the coverage area.

Applicants respectfully request Examiner to reconsider the rejection in light of Applicants' amendments and the following argument. To further Applicants' position of the patentability of amended claim 37 (and amended claims 38-40 that depend from amended claim 37), Applicants note the following.

On page 11 of the Office Action, with respect to independent claim 37,

(1) Examiner states that Treyz discloses a system in which a handheld computing device may be used to provide a user with shopping assistance services and consequently a method of utilizing executable code in a handheld device receiving a signal from a transmitter, said method comprising the steps of: receiving said signal at a communication interface communicatively associated with said handheld device (col. 55, lines 30-40);

As a rebuttal to Examiner's position, Applicants respectfully point out that Treyz discloses that promotional material may be targeted based on the user's preferences and interests and based on the user's location in the supermarket. As previously pointed out, Treyz further discloses that the handheld computing device determines its locational context. Nowhere does Treyz disclose a handheld device receiving a signal formatted by a transmitter.

(2) Examiner states that Treyz is silent on passing the information to the handheld device formatted as an XML element.

(3) Examiner states that Aufricht discloses an interactive advertisement mechanism enabled to be loaded on a mobile device and for users of mobile devices to operate with such interactive advertisements on their mobile devices in an interactive manner while in an off-line mode.

Applicants respectfully request clarification of Examiner's comment. Applicants respectfully point out that Applicants claim a method for utilizing executable code in a handheld device receiving a signal formatted by a transmitter. Thus the handheld device is not in an off-line mode.

(4) Examiner states that Aufricht allows for placing objects such as interactive advertisements such as Internet of Web content on mobile devices (paragraph 33). Examiner states that Aufricht meets the following limitation: establishing a preference for information contained in said signal, said information being formatted as an XML element (paragraph 33 and Table 1 [placing interactive advertisements from the internet or Web content to mobile devices with XML being one of the allowable forms]).

As a rebuttal to Examiner's position, Applicants respectfully point out that, as Examiner has stated, Aufricht discloses an interactive advertisement mechanism enabled to be loaded on a mobile device. Applicants, on the contrary, claim a method of utilizing executable code in a handheld device receiving a signal formatted by a transmitter. Nowhere do either Treyz or Aufricht disclose or suggest a transmitter for formatting a signal for a handheld device.

On page 12 of the Office Action, with respect to dependent claim 39, Examiner states that Aufricht meets the limitation – The method of claim 37 wherein said coverage area defines a context for said user receiving said emitted signal (paragraph 180).

As a rebuttal to Examiner's position, Applicants respectfully point out that Aufricht discloses a server that transmits advertisements to a handheld device that are specific to the characteristics / preferences of an individual. Nowhere does Aufricht disclose a transmitter formatting an emitted signal in conjunction with defining a context in the transmitter based on the coverage area of the transmitter.

Since Treyz and Aufricht, separately or in combination, do not teach or suggest each and every element of Applicants' amended independent claim 37, either expressly or inherently, Applicants' amended claim 37 (as well as amended dependent claims 38-40 that depend, either directly or indirectly, therefrom and that further define the invention) is not made obvious by the Treyz and Aufricht, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that amended independent claim 37 (as well as amended claims 38-40 that depend, directly or indirectly, therefrom) is now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 103(a) with regards to amended claims 37-40 for the reasons set forth above.

Allowable Subject Matter

On page 13 of the Office Action,

(1) Examiner states that claims 25-28 are allowed. Applicants have amended these claims to make their formats consistent with the other claims and to further define the invention.

(2) Examiner states that claims 6, 16-18, 30, and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 6, 16-18, 30, and 40 are believed to be in condition for allowance.

Conclusion

Claims 1-18, 21-22, and 24-43 are believed to be in condition for allowance. All dependent claims are believed to depend upon allowable independent claims, and are therefore also in condition for allowance.

Although it is believed that no new fees are due as a result of the claim amendments, the Commissioner for Patents is authorized to charge additional fees or credit overpayment to Deposit Account No. 03-2410, Order No. 12078-141.

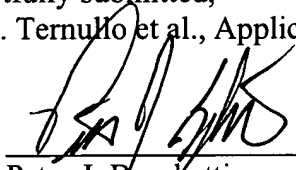
The following information is presented in the event that a call may be deemed desirable by the Examiner:

PETER J. BORGHETTI (617) 854-4000

Date: December 23, 2004

Respectfully submitted,
Noah J. Ternullo et al., Applicants

By:



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